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10/801,697	03/17/2004	Toshiaki Ishii	1021.43671X00	1862

20457 7590 06/22/2010  
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EXAMINER
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GRAYBILL, DAVID E

ART UNIT	PAPER NUMBER
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2894

MAIL DATE	DELIVERY MODE
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06/22/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the feature(s) canceled from the claim(s). No new matter should be entered:

Re claim 21: the bonding wires are provided only over the first major surface of the heat sink to which the multilayered wiring board and the portion of the at least one end of the polyimide wiring board are fixed.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the

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examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8, 21-26 and 28-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The undescribed subject matter is the following:

Re claim 21: the bonding wires are provided only over the first major surface of the heat sink to which the multilayered wiring board and the portion of the at least one end of the polyimide wiring board are fixed.

In particular, the language is a negative limitation which excludes wherein the bonding wires are provided other than over the first major surface of the heat sink to which the multilayered wiring board and the portion of the at least one end of the polyimide wiring board are fixed, and any negative limitation or exclusionary proviso must have basis in the

original disclosure. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983) *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation or drawing illustration is not basis for an exclusion.

Indeed, in FIG. 7, the bonding wires 21 are provided more than over the first major surface of the heat sink to which the multilayered wiring board and the portion of the at least one end of the polyimide wiring board are fixed; e.g., the bonding wires are also provided over the resin 7.

Furthermore, the figures are not limited to an absolute frame of reference or otherwise limited to a particular orientation, and it is inherent that there is a frame of reference wherein the bonding wires are provided other than over the first major surface of the heat sink to which the multilayered wiring board and the portion of the at least one end of the polyimide wiring board are fixed.

Claims 8, 21-26 and 28-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The undescribed subject matter is the following:

Re claim 21: the bonding wires are provided only over the first major surface of the heat sink to which the multilayered wiring board and the portion of the at least one end of the polyimide wiring board are fixed.

To further clarify, one skilled in the art would be unable to make and/or use the invention because it is inherent that there is necessarily a frame of reference wherein the bonding wires are provided other than over the first major surface of the heat sink to which the multilayered wiring board and the portion of the at least one end of the polyimide wiring board are fixed.

The remarks filed on 03-22-10 have been fully considered, however, they do not overcome the 112 first paragraph rejection supra.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

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advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**For information on the status of this application applicant should check PAIR:**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Alternatively, applicant may contact the File Information Unit at (703) 308-2733. Telephone status inquiries should not be directed to the examiner. See MPEP 1730VIC, MPEP 203.08 and MPEP 102.**

Any other telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (571) 272-1930. Regular office hours: Monday through Friday, 8:30 a.m. to 6:00 p.m.  
The fax phone number for group 2800 is (571) 273-8300.

/David E Graybill/  
Primary Examiner, Art Unit 2894